

**REMARKS**

Claims 52 through 54 are currently pending in the application.

This amendment is in response to the Office Action of December 24, 2003.

**Information Disclosure Statement(s)**

Applicants note the filing of two Information Disclosure Statement on May 30, 2003 and October 6, 2003 and note that copies of the PTO-1449s were not returned with the outstanding Office Action. Applicants respectfully request that the information cited on the PTO-1449 be made of record herein.

**35 U.S.C. § 102(b) Anticipation Rejections**

**Anticipation Rejection Based on Solomon (U.S. Patent 5,067,233)**

Claims 52 and 54 are rejected under 35 U.S.C. § 102(b) as being anticipated by Solomon (U.S. Patent 5,067,233).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants assert that the presently claimed invention of claims 52 and 54 is not anticipated under 35 U.S.C. § 102 by the Solomon reference because the presently claimed invention does not identically describe, either expressly or inherently, the presently claimed invention in as complete detail as is contained in the presently amended claims.

Turning to the cited prior art, the Solomon reference describes a method of forming an integrated circuit module including a plurality of integrated circuit layers having beveled vertical edges along a portion thereof connected to a contact board disposed orthogonal to the layers and also having a beveled first surface formed to receive and support the integrated circuit layers. The contact board 13 has beveled edges 15 formed by anisotropically etching single crystalline silicon.

Applicants assert that the Solomon reference does not identically describe, either expressly or inherently, the elements of the presently claimed invention of presently amended independent claim 52 calling for “forming a contact head from a conductive material as at least one member of a socket contact having at least two members forming portions thereof, the contact head for contacting one of the contacts of the IC chip for use in the testing thereof”, “forming a contact body from a doped semiconductive material configured to be electrically conductive as a member of a socket contact having at least two members forming portions thereof, the contact body formed from a doped semiconductive material for use in the testing of the IC chip”, and “joining said contact head and said contact body forming a socket contact having at least two members forming portions thereof, the joined contact head and the contact body having at least a portion of the contact head contacting at least a portion of a contact of the IC chip during the testing thereof”. Applicants further assert that the Solomon reference does not describe the element of the presently claimed invention of amended dependent claim 54 calling for “wherein said joining said contact head and said contact body further comprises depositing a metal over a doped silicon surface for a socket contact having at least two members forming portions thereof”.

Applicants assert that the Solomon reference describes no such elements of the presently claimed invention of presently amended independent claim 52 whatsoever to anticipate the presently claimed invention under 35 U.S.C. § 102. The Solomon reference solely describes a single crystalline silicon material, not the presently claimed doped semiconductor material.

Therefore, presently amended independent claim 52 and dependent claims 53 and 54 therefrom are allowable.

### **35 U.S.C. § 103(a) Obviousness Rejections**

#### **Obviousness Rejection Based on Solomon (U.S. Patent 5,067,233)**

Claim 53 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Solomon (U.S. Patent 5,067,233). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants further submit that to establish a *prima facie* case of obviousness under

35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

Applicants assert that the Solomon reference to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed inventions of presently amended independent claim 52 and presently amended dependent claim 53 therefrom because, at the very least, the Solomon reference fails to teach or suggest the all the claim limitations of the presently claimed inventions. More specifically, Applicants assert that the Solomon reference fails to teach or suggest the claim limitations of presently amended independent claim 52 calling for "forming a contact head from a conductive material as at least one member of a socket contact having at least two members forming portions thereof, the contact head for contacting one of the contacts of the IC chip for use in the testing thereof", "forming a contact body from a doped semiconductive material configured to be electrically conductive as a member of a socket contact having at least two members forming portions thereof, the contact body formed from a doped semiconductive material for use in the testing of the IC chip", and "joining said contact head and said contact body forming a socket contact having at least two members forming portions thereof, the joined contact head and the contact body having at least a portion of the contact head contacting at least a portion of a contact of the IC chip during the testing thereof" as well as the claim limitations of the presently claimed invention of dependent claim 53 calling for "said forming a contact head comprises stamping a metal element as at least one member of a socket contact having at least two members forming portions thereof", "said forming a contact body comprises etching silicon having at least a portion thereof doped to be electrically conductive as at least one member of a socket contact having at least two members forming portions thereof", and "said joining said contact head and said contact body further comprises

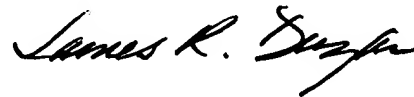
adhering said contact head onto said contact body forming a socket contact having at least two members forming portions thereof”.

Applicants assert that the Solomon reference contains no teachings or suggestions whatsoever concerning such claim limitations of the presently claimed inventions. Therefore, presently amended independent claim 52 and dependent claim 53 therefrom are allowable.

In summary, Applicants submit that claims 52 through 54 are clearly allowable over the cited prior art.

Applicants request the allowance of claims 52 through 54 and the case passed for issue.

Respectfully submitted,



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